



UNITED STATES PATENT AND TRADEMARK OFFICE

76

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,927	10/22/2003	Scott Gerald Allam	B55-0010	1612

7590 05/15/2006

James E. Fay
1096 Reed Street
Neenah, WI 54956

EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/691,927

Applicant(s)

ALLAM ET AL.

Examiner

Adam M. Queler

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Application filed October 22, 2003, and Election filed 04/22/2006.
2. Claims 1-10 are pending in the case. Claim 1 is an independent claims.

Election/Restrictions

3. Applicant's election without traverse of group I in the reply filed on 4/22/2006 is acknowledged.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 09/738,598 in view of Rivette. The co-pending claims recite all the elements of the instant claims except the navigational tool. Rivette teaches a navigational tool (Fig. 14, 165). It would

Art Unit: 2178

have been obvious to one of ordinary skill in the art at the time of the invention to use a navigational tool as it would have enabled the user to more easily navigate.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-10 rejected under 35 U.S.C. 102(e) as being anticipated by Allam (US 20020116420A1).**

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding independent claim(s) 1, Allam teaches a method for viewing electronic information comprising the steps of: displaying in a first window a physical page from an electronic document containing information from a predefined page format, wherein the electronic document comprises representations of at least one physical page, and a visual reference

Art Unit: 2178

emphasizing information on the at least one physical page, extracting the information emphasized by the visual reference on the at least one physical page (claim 1), presenting the extracted information in a second window Fig. 4 and presenting a navigation tool in a third window (Fig. 6).

Regarding dependent claim(s) 2, Allam teaches wherein the physical page is represented in an electronic page view (claim 2).

Regarding dependent claim 3, Allam teaches the physical page is represented as an icon including a thumbnail of the physical page (claim 3).

Regarding dependent claim 4, Allam teaches the first and second window are the same window (claim 4).

Regarding dependent claim 5, Allam teaches the second window is an enhanced interactive window including a thumbnail image of a physical page, a graphic image of a physical page, text, free flowing text, icons, hyperlinks, menus, and control elements (claim 5).

Regarding dependent claim 6, Allam teaches the navigation tool presents an extraction of content and annotations (para. 46).

Regarding dependent claim 7, Allam teaches the step of selecting further comprises the step of enclosing the annotation with a box (claim 7.)

Regarding dependent claim 8, Allam teaches the second window may be placed in various positions relative to the first window, including on top of the first window, adjacent to the first window, and partially covering the first window (claim 8).

Regarding dependent claim 9, Allam teaches the second window further comprises a control panel for managing the extracted information (claim 9).

Art Unit: 2178

Regarding dependent claim 10, Allam teaches the extracted information may be viewed simultaneously in a multiple of enhanced interactive windows (claim 10).

8. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al. (US006018749A).

Regarding independent claims 1, Rivette teaches displaying in a first window a physical page (Fig. 59). The window surrounding the text is the visual reference, which is disposed on the physical page. Rivette teaches extracting the information on the physical page (col. 19, line 65 – col. 21, line 11). Rivette teaches presenting the extracted information in a second window and that the information is free-flowing (Fig. 59). Rivette teaches a navigational tool (Fig. 14, 165).

Regarding dependent claim 2, Rivette teaches the physical page is represented in an electronic page view (Fig. 59).

Regarding dependent claim 3, Rivette discloses that the physical page is represented as an icon including a thumbnail of the physical page (Fig. 65).

Regarding dependent claim 4, Rivette discloses the first and second windows are the same window (Fig. 59, Patentworks window).

Regarding dependent claim 6, Rivette discloses the step of extracting information further comprises the step of selecting a markup annotation from the physical page and converting the information contained in the selected markup annotation to information for use in the second window (col. 41, ll. 18-44).

Regarding dependent claim 7, Rivette discloses the step of selecting further comprises the step of enclosing the markup annotation with a box (Fig. 61).

Art Unit: 2178

Regarding dependent claim 9, Rivette discloses the second window further comprises a control panel for managing the extracted information (col. 33, ll. 64-67.).

Regarding dependent claim 10, Rivette discloses the extracted information may be viewed simultaneously in a multiple of enhanced interactive windows (col. 37, ll. 39-55).

Conclusion

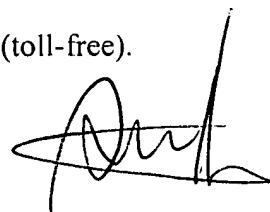
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M. Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ


STEPHEN HONG
SUPERVISORY PATENT EXAMINER